

REMARKS

Summary of Office Action

Claims 250 and 571-886 are currently pending.

Independent claims 250, 571, 645, 650, 732 and 810 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aristides et al., United States Patent No. 5,657,072 (hereinafter "Aristides") in view Lawler et al., United States Patent No. 5,805,763 (hereinafter "Lawler") and in further view United States Patent No. 6,006,257 to Slezak (hereinafter "Slezak").

Dependent claims 572-644, 646-649, 651-731, and 811-886 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aristides in view of Lawler and Slezak and, in some instances, in further view of various other references and/or Official Notice(s) taken by the Examiner.

Summary of Telephonic Interview

Examiner Lonsberry and the undersigned agent of record (hereinafter "applicants' representative") conducted a telephonic interview on March 6, 2007. Applicants' representative wishes to thank the Examiner for the courtesies extended during the interview.

The Examiner and applicants' representative discussed the combination of Aristides and Lawler. Applicants' representative pointed out that both Aristides and Lawler need to be considered as a whole and that Aristides teaches away from the proposed combination with Lawler as well as applicants' claimed invention.

At the conclusion of the interview, the Examiner indicated that applicants' representative raised a valid argument and requested that the argument be included in this Reply.

The Examiner also mentioned at the conclusion of the interview that an amendment to the claims would help further the prosecution of this case. In particular, the Examiner suggested amending the claims to: (1) clarify how the Internet service system provides program guide data and (2) specify that the Internet service system is independent from a headend system.

Summary of Applicants' Response to the Office Action

Claims 250, 571, 645, 650, 732 and 810 have been amended per the Examiner's suggestion. The amended claims are fully supported and justified by the originally filed specification. See, e.g., page 17, lines 6-13 of applicants' originally filed specification. Applicants traverse the rejections based on the combination of Aristides, Lawler and Slezak. Applicants also traverse the Official Notices taken by the Examiner.

Applicants' Reply to the 35 U.S.C. 103 Rejections

Claims 250 and 571-886 are currently pending. Claims 250, 581, 587, 607, 645, 649, 650, 654, 671, 692, 732, 749, 770, 810, 826, and 847 have been amended.

Independent claims 250, 571, 645, 650, 732, and 810 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Aristides in view of Lawler and in further view of Slezak. Independent claims 250, 571, 645, 650, 732, and 810, as amended, recite a remote media server configured to store and play back programs on-demand for a number of users and a headend which provides broadcast programming. In addition, an Internet service system, which is configured to provide program guide data using an Internet based approach, is used to provide requests to the remote media server (see

claims 250 and 732) or implement an online interactive television program guide (see claims 571, 645, 650 and 810).

Aristides is generally directed to "alleviat[ing] the bottleneck associated with handling many requests during peak activity times" (Aristides, col. 3, lines 7-9). Aristides is concerned that the infrastructure connecting the headend to the users has a limited capacity and that capacity is strained when the users communicate with the headend (see Aristides, col. 7, lines 34-39). According to Aristides, this creates a "bottleneck" problem, which is exacerbated when many users communicate with the headend during "peak activity times" (id.). Aristides solves the bottleneck problem by reducing the number of user requests for information from the headend during peak activity times (see, e.g., Aristides, col. 7, lines 40-45).

The Office Action states that "Aristides fails to disclose an EPG that [1] generates a record request in response to the user indicating a desire to record a program on-demand with a remote media server, [2] storing the requested program remotely and [3] an Internet service system." The Office Action relies on Lawler to fill deficiencies 1 and 2.*

In particular, the Examiner analogizes applicants' "record requests" with Lawler's "record tags."** Lawler's

* The Office Action relied on Slezak to fill deficiency 3. Applicants hereby submit that Slezak also cannot be combined with Aristides or Lawler. In addition, applicants submit that the combination of Aristides, Lawler and Slezak fails to show or suggest all of the claim elements. Applicants reserve the right to further explain these submissions if necessary.

** Applicants hereby submit that the "record requests" recited by applicants' claims are different than Lawler's "record tags" and reserve the right to explain further if necessary.

record tags "can be though [sic] of as a request to the system to record a program. Each record tag is associated with a program to be recorded and the viewer station or user that set the record tag" (Lawler, col. 12, lines 58-60). The headend monitors all of the record tags that are set by various system users and activates recording equipment at the appropriate time(s) (see Lawler, col. 13, lines 11-27). Record tags are sent to the headend regardless of whether the program will be recorded at the viewer's end or at the headend (see id.).

The intended purpose of Aristides is to alleviate the bottleneck caused by a number of user requests being sent to the headend (see Aristides, col. 3, lines 7-9). Lawler, on the other hand, sends record tags to the headend, even when the program is being recorded on a local storage device, which results in large numbers of user requests being sent to the headend. By doing so, Lawler would exacerbate the very bottleneck problem that Aristides sought to alleviate. Therefore, the modification of Aristides with Lawler would render Aristides unsatisfactory for Aristides' intended purpose of minimizing the number of user requests sent to the headend. Because cited references must be considered in their entirety, i.e., as a whole, including portions that would lead away from the claimed invention, Aristides teaches away from applicants' invention and its combination with Lawler because Aristides is directed to minimizing a user's interaction with the headend. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For at least the above reasons applicants' amended independent claims 250, 571, 645, 650, 732, and 810 are patentable over the combination of Aristides and Lawler. Claims 655-731, 572-644, 646-649, 651-654, 733-809,

and 811-886 depend from independent claims 250, 571, 645, 650, 732, and 810 respectively. Accordingly, the rejections of dependent claims 655-731, 572-644, 646-649, 651-654, 733-809, and 811-886 should also be withdrawn. ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.)

Applicants' Reply to the Official Notices

In the previous Office Action, which was mailed on May 31, 2005, the Examiner took a number of Official Notices when rejecting some of applicants' previously pending claims. In particular, rather than provide documentary evidence to support some of the 35 U.S.C. § 103(a) rejections, the Examiner took official notice that some of the claimed features were "notoriously well known in the art" (previous Office Action, pages 7, 8, 10-15 and 19).

Some of the previously pending claims, however, were found allowable by the Examiner. No Official Notices were taken in connection with the allowable claims. To expedite the issuance of the allowable claims, the rejected claims were canceled without prejudice in applicants' Reply to the previous Office Action, which applicants' mailed on August 31, 2005. In addition to canceling the rejected claims, the Reply to the previous Office Action stated that:

applicants submit that the claims are in allowable form, rendering a response to the rejections of the claims prior to amendments and cancellations unnecessary. Nevertheless, applicants reserve the right to contest the rejections of the claims prior to the amendments and cancellations, which include the Official Notices taken by the Examiner.

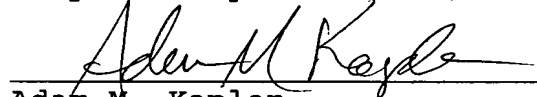
Applicants' Reply to the previous Office Action, page 93, lines 20-26. Therefore, the Examiner's submission on page 2 of the outstanding Office Action that applicants failed to traverse the Official Notices taken in the previous Office Action is incorrect, at least because applicants reserved the right to contest the Official Notices that were directed to the claims that were being canceled. Moreover, applicants submit that this is the first time any Official Notice has been asserted against the currently pending claims.

In addition, the claim features, for which Official Notice was taken in the outstanding Office Action, were not well-known at the time of the filing of the present application. Applicants also submit that the Examiner has not provided substantial evidence that these features are notoriously well-known in the art. Therefore, according to MPEP § 2144.03, applicants respectfully submit that the Examiner is required to cite a reference to support each of the Official Notices used to reject the currently pending claims if the rejections are to be maintained.

Conclusion

For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Reconsideration in light of the foregoing remarks and a favorable action are respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Adam M. Kaplan", is written over a horizontal line.

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